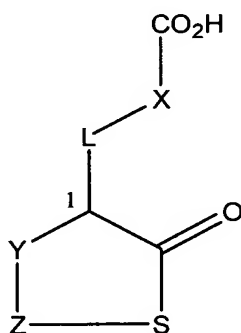


Claim Rejections – 35 U.S.C § 102

Claims 1-5 stand rejected under 35 U.S.C. 102 (a) as being anticipated by Jonker (Canadian Patent Application Number 2,434,117, PCT Application Number GB 2002/000072, published July 11, 2002). Applicants respectfully traverse this rejection.

The evidence and arguments of record fail to establish that Jonker anticipates claims 1-5. The Office argues that “Jonker discloses compounds that anticipate the instantly claimed genus wherein: Z is $-(CR_5R_6)_n$, n is 1 or 2; L is NR_1 ; X is C1-C20 acyl chain (see Jonker, claim 8, page 31, line 23).” Office action, page 9, penultimate paragraph. The “claimed genus” refers to formula I of claim 1:



Although formula I contains a carboxy functional group, nothing in the evidence and arguments of record suggests that Jonker discloses a carboxy-substituted compound.

To anticipate a claimed compound, the prior art reference must “clearly and unequivocally disclose the claimed compound or direct those skilled in the art to the compound without any need for picking, choosing, and combining various disclosures...” *In re Arkley*, 455 F.2d 486, 487, 172 U.S.P.Q. 524, 526 (C.C.P.A. 1972). The reference must, therefore, provide a certain degree of precision with respect to the specific compound claimed. For example, in *Ex parte Westphal*, 223 U.S.P.Q. 630 (Bd. Pat. App. 1983), the claim was directed to a composition containing 3-methylthio-4-amino-6-*tert*-butyl-1,2,4-triazine-5-one. The Office rejected the claim under § 102 as anticipated by, *inter alia*, a patent to Fawzi. Although the Fawzi patent disclosed a compound substituted at a particular position with alkyl having 1 to 8 carbon atoms, it did not specifically name the claimed *tert*-butyl radical. Thus, the Board found that the Fawzi patent did not provide the precision necessary for anticipation under § 102.

In the instant case, Jonker merely recites that "Z is substituted or unsubstituted C1 to C20 acyl chain" (claim 8). Since the evidence and arguments of record fail to show that Jonker specifically mentions a carboxy substituted acyl chain, the Office has not proven that Jonker provides the requisite precision for anticipation. Accordingly, applicants respectfully request withdrawal of this rejection.

Allowable subject matter

Applicants acknowledge with appreciation the Examiner's indication of allowable subject matter in claims 40 and 42.

Conclusion

Applicants believe that the present application is now in condition for allowance. Favorable reconsideration of the application is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

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By [Signature]
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